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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,795	04/02/2004	Joachim Hossick-Schott	P-11709.00	9917
27581	7590	11/25/2005	EXAMINER	
MEDTRONIC, INC. 710 MEDTRONIC PARK MINNEAPOLIS, MN 55432-9924			THOMAS, ERIC W	
			ART UNIT	PAPER NUMBER
			2831	

DATE MAILED: 11/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/816,795

Applicant(s)

HOSSICK-SCHOTT, JOACHIM

Examiner

Eric Thomas

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-22 are drawn to method of manufacturing, classified in class 438, subclass 691.
- II. Claims 23-30, are drawn to product (device), classified in class 257, subclass 144.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case that the process as claimed can be used to make other and materially different product such as an anode.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Paul McDowell on November 09, 2005 a provisional election was made with traverse to prosecute the invention of group II, claims 23-30. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Objections***

1. Claim 30 is objected to because of the following informalities:

Claim 30, line 1, the limitation, "a pair of capacitors" is confusing. Does this pair include the capacitor already claimed? The examiner interpreted this claim as if the pair of capacitors includes the capacitor already claimed. Appropriate correction is required.

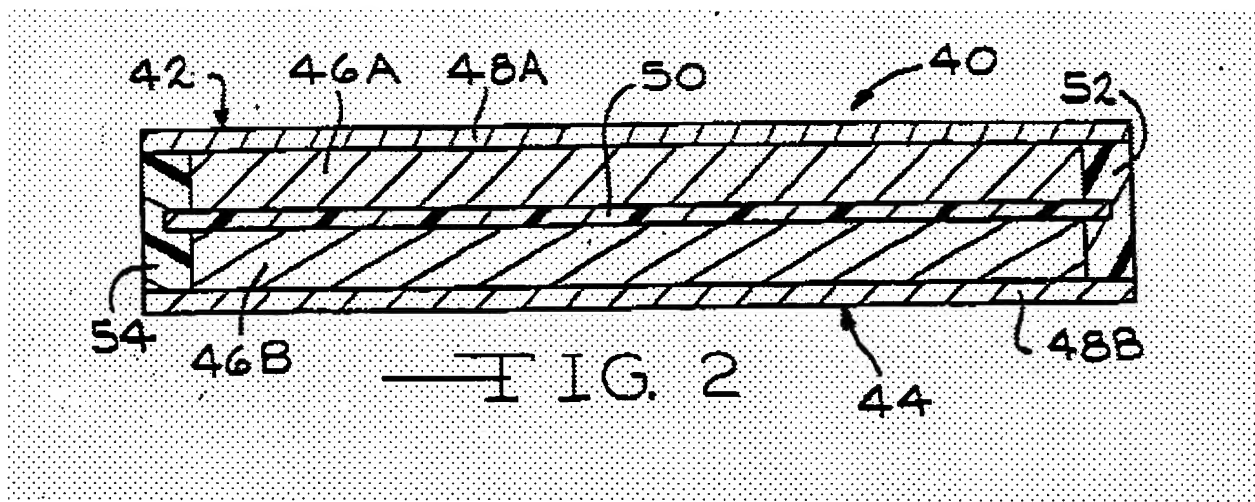
### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 23-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Shah et al. (US 2001/0026850).



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Shah et al. disclose in fig. 2, a carbide cathode consisting of a titanium (paragraph 25) substrate (48a), and a layer (46A) of titanium carbide (paragraph 30) disposed on a surface portion of said substrate.

Regarding claim 24, Shah et al. disclose the titanium substrate comprises a substantially flat sheet of titanium.

Regarding claim 25, Shah et al. disclose the titanium substrate comprises an interior portion of a casing (substrate portion – element 48a) for a capacitor (see fig. 2).

Regarding claim 26, Shah et al. disclose the capacitor further comprises: a valve metal anode (44) spaced from the cathode, a porous separator (50) material disposed between the valve metal anode and the cathode; and a liquid electrolyte (paragraph 45) in fluid communication with both the valve metal anode and the cathode.

Regarding claim 27, Shah et al. disclose the valve metal anode comprises a tantalum anode slug (see fig. 4 – element 86 – paragraph 47).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shah et al. (US 2001/0026850) in view of Fain (US 5,709,711).

Shah et al. disclose the claimed invention except for the capacitor is operatively coupled within an implantable medical device

Fain teaches that it is known in the capacitor art to operatively couple a capacitor within an implantable medical device (cardioverter-defibrillator – see col. 1 lines 5-20).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the capacitor of Shah et al. in a cardioverter-defibrillator system of Fain, since such a modification would provide a system for the capacitor to operate in and would provide the system with a capacitor having high capacitance and capacitance density.

Regarding claim 29, Fain teaches the implantable medical device comprises a cardioverter-defibrillator.

Regarding claim 30, Fain teaches that a pair of capacitors operatively coupled within the cardioverter-defibrillator.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5,754,394 – cathode comprising a carbide coating.

4,456,518 – cathode comprising a titanium substrate and a titanium carbide coating form on said substrate.

2001/0024700 – ultrasonically coated substrate for use in a capacitor.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Thomas whose telephone number is 571-272-1985. The examiner can normally be reached on Monday - Friday 6:30 AM - 3:45 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-1984. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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ERIC W. THOMAS  
PRIMARY EXAMINER